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REMARKS CONCERNING THE AMENDMENTS

The above amendments have been made in an effort to respond to issues of claim dependency and to more clearly define the invention.

New claims 35 and 36 state the limitation already present in claim 20 that "...the suit and rank of a card displayed is the suit and rank of a missing card." There is literal antecedent basis for that language in previous claim 20 and generally in the specification, such as for example, page 7, lines 18-24.

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SUMMARY OF THE OFFICE ACTION

1. Claims 21 and 34 were rejected under 35 USC 112, second paragraph as depending from a cancelled claim.
2. Claims 20, 21, 25-31 and 34 have been rejected under 35 USC 103(a) as obvious over the combination of U.S. Patent No. 5,989,122 (Roblejo) in view of U.S. Patent No. 6,149,154 (Grauzer) in view of U.S. Patent No. 4,339,134 (Macheel).

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RESPONSE TO THE REJECTIONS

1. Claims 21 and 34 were rejected under 35 USC 112, second paragraph as depending from a cancelled claim.

Claims 21 and 34 have been amended to provide proper claim dependency.

2. Claims 20, 21, 25-31 and 34 have been rejected under 35 USC 103(a) as obvious over the combination of U.S. Patent No. 5,989,122 (Roblejo) in view of U.S. Patent No. 6,149,154 (Grauzer) in view of U.S. Patent No. 4,339,134 (Macheel).

The rejection asserts that Roblejo shows all of the structural elements of the claims except for:

a) the specific location of the card sensor between the card holding (input) area and the card collecting area (the delivery tray);
b) the signaling of a surplus or missing card; and
c) the visual signaling means displaying the suit and rank of a card read by the sensor/card reader.

The rejection thereafter asserts that:

a) Grauzer shows the specific location of the card sensor between the card holding (input) area and the card collecting area (the delivery tray) and it would be obvious to incorporate that structural feature into the design of the Roblejo shuffler;
b) "the signaling of a surplus or missing card is inherent in said signaling operation" of Roblejo where there is a visual means of signaling a network administrator that a deck of cards is either incomplete or inaccurate (Column 4, lines 8-14); and
c) Macheel teaches a card randomizing apparatus with a display that can identify a particular card by rank and suit, so that it would have been obvious to one of ordinary skill in the art to incorporate the display of Macheel into the shuffler of Roblejo for the purpose of identifying a particular card by suit and rank.

This rejection is respectfully traversed.

The specific disclosure that the rejection relies upon from Roblejo to assert the obviousness of element b) is faulty, both in content and in legal basis. The specific language in the cited text at Column 4, lines 8-14 is:

> "The apparatus and process of the invention verifies that the set of one or more decks which is processed is complete and accurate; otherwise, when an incorrect set is determined, the apparatus sends a signal, either audible, visual, to a network administrator, by ejecting a card which does not belong in the set, or by any other means to indicate an inaccurate deck."

This broadest reading of this disclosure shows that "...the apparatus sends a signal...by any...means to indicate an inaccurate deck." There is nothing in that disclosure to indicate that a specific card, by rank and suit, is displayed on an imaging display on the shuffler is the nature of the defect in the deck. Even though "a signal" is a broad term, that fact does not mean that there is a teaching that a specific signal such as the image or name of a specific card by suit and rank is displayed on the shuffler as that signal. That is not an "inherent teaching," but rather an impermissible extension of the teaching by hindsight, without guidance from the teachings of a reference of record in the rejection. Even if a secondary reference is found that shows display of a card image by rank and suit, that does not mean that it would have been obvious to those skilled in the art at the time the present invention was made to incorporate this teaching into Roblejo to display suit and rank of a card as an identification of the nature of a defect in a deck. That fundamental teaching is absent from the references of record and the rejections must fail because of the absence of that teaching.

The "signal" shown by Roblejo would more likely have to fall within the realm of "Deck Error" or the like. This is especially true with respect to the limitation in claim 20 and new claims 35 and 36 that the card displayed is an identity of a card absent from the deck. This would require a system in which a databank provides a list of cards present in a deck, a program where the scanned images are collectively compared to that databank, an absent card is identified, and an image/alphanumeric from the databank of the absent card is then sent to the display. This would therefore encompass an image that has not been scanned by the reader to be displayed. That concept is also absent from the teachings of the reference.

Roblejo teaches ejecting excess cards. As cards are automatically ejected, and there is no disclosure to the contrary, display of the suit and rank of the ejected cards is not taught, even if the suit and rank were known. All that is taught is a visible signal of a deck defect. Johnson (the present inventor) displays the specific identity of the card that is to be removed. This enables manual removal of the erroneous card or replacement of the missing card, a solution not available to Roblejo. As Roblejo provides a completely different solution to deck defect problems, and the present claims define a solution that provides a more definitive solution to multiple problems, the claims invention is not obvious from the teachings of Roblejo.

There also is some significant question as to the enablement of Roblejo, even with regard to the 'specific' signaling functions provided, such as the ejection of the card that does not belong in the set. As Roblejo has fewer slots in the carousel than cards in the deck, there is no explanation as top how a single card be transported and ejected by the carousel to the ejection zone. It must be remembered that the likelihood of the discovery of an extra card would be found towards the ends of the deck analysis (i.e., the first card cannot be identified as an extra card), so slots in the carousel are likely to be filled or contain other cards during discovery of an extra card. When there are multiple decks present, within the teachings of Roblejo, the entire collection of cards is likely to have to be read before such a determination is made. This emphasizes the inference that much of the teaching of Roblejo is prophetic and enablement and extension of the teachings is more like a wish piled upon a wish as opposed to following the trail of a detailed technical disclosure. Asserting "inherency" from such a problematic teaching is an insufficient basis for asserting obviousness under 35 USC 103(a) and fails in the present instance. There is a much higher legal sufficiency requirement for inherency than is available from this teaching.

> "In order for a disclosure to be inherent, however, the missing descriptive matter must necessarily be present in the parent application's specification such that one skilled in the art would recognize such a disclosure. *See Continental Can Co. USA, Inc. v. Monsanto Co.*, 948 F.2d 1264, 1268 20 U.S.P.Q.2d (BNA) 1746, 1749."
>
> "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. If, however, the disclosure is sufficient to show the natural result

> flowing from the operation as taught would result in the performance of the questioned function, it seems well settled that the disclosure would be regarded as sufficient." *In re Oelrich*, 666 F.2d 578, 581, 212 U.S. P.Q. (BNA) 323, 326 (C.C.P.A., 1981).

The teachings of Roblejo fail to meet these Patent Law standards for inherency, and the use of such an assertion is both factual and legal error.

Grauzer does not have any impact upon the failure of Roblejo discussed above. Although Grauzer does show a different location for the card reader than that shown by Roblejo, there is no disclosure of the display of particular card deficiencies or excesses in a read deck on a display as recited in the claims and as absent from Roblejo.

The addition of Macheel to the combination of Roblejo and Grauzer also fails to correct the deficiencies discussed above with respect to Roblejo in view of Grauzer. Macheel shows an entirely electronic blackjack system in which card values are displayed. The present invention never asserted invention solely for the ability to display a card image. One limitation recited in the claims as an element of the invention is the detection of a specific card identification flaw in a set of cards (e.g., a card missing from the set or an extra card in the set) and the display of that exact card identification flaw, especially on a display on the shuffler. That is one limitation in the claims that is absent from the combined teachings of Roblejo in view of Grauzer and Macheel. Macheel is the only reference (asides from the asserted inherency of Roblejo which has been shown to be in error) that is cited to show that limitation of the claims. As Macheel cannot have a card identification flaw except by improper software in the device (there are no physical cards), it is impossible for Macheel to overcome the deficiencies of the Roblejo in view of Grauzer combination. The rejection is in error and must be withdrawn.

As noted above, none of the references can show the limitations of claims 35 and 36 with regard to showing the identification of card not present in the set of cards, without further teachings from additional art that is not of record in the rejection, if such art exists. Claims 20 (which also contains this limitation), 35 and 36 are therefore patentable on the basis of this additional argument.

CONCLUSION

Applicants assume the application is now in proper order and in condition for examination and allowance after showing that all rejections of record have been overcome by amendment are in error on both a factual and legal basis. Please direct any inquiries to the undersigned attorney at (952) 832-9090.

Respectfully submitted,

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Date: 8 NOVEMBER 2006 By: _____
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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this Transmittal Letter and the paper, as described herein, are being sent by facsimile to the United States Patent and Trademark Office, addressed to: **Mail Stop: AMENDMENT**, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 on 8 NOVEMBER 2006.

Mark A. Litman
Name

Signature